

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KANJI NAKANISHI

Appeal No. 2006-0491
Application No. 09/688,134

HEARD: MARCH 21, 2006

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before HAIRSTON, RUGGIERO, and BLANKENSHIP, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 18.

The disclosed invention relates to a method and apparatus for printing information and ad data received from a network.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A network data terminal for printing information obtained from a network comprising:
 - a printer that is connectable to or incorporated into the data terminal, and is capable of printing on opposite sides of a recording sheet;
 - a memory device for storing ad data received from the network;

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a device for allowing a user of the data terminal to choose whether to print the ad data on the same side of a recording sheet as the information or on the opposite side from the information;

a print control device that produces print image data for one side or for both sides from the information and the ad data in accordance with which side of the recording sheet the ad data is to print, and controls the printer in accordance with the print image data; and

a charge modification data sending device for sending data for modifying charge for provision of the information in accordance with amount of ad data printed with the information.

The references relied on by the examiner are:

Shimizu	5,987,230	Nov. 16, 1999
Yokomizo et al. (Yokomizo)	6,321,266	Nov. 20, 2001
	(effective filing date Jan. 18, 1994)	

Claims 1 through 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimizu in view of Yokomizo.

Reference is made to the briefs and the answer for the respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the obviousness rejection of claims 1 through 18.

According to the examiner's findings (answer, pages 4 and 5), Shimizu discloses all of the elements of claim 1 except for a charge modification data sending device. For such a teaching the examiner turns to Yokomizo which allegedly teaches "a Centronics

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I/F controller (abstract; col. 1, line 1 - col. 5, line 5) which performs an I/F control for connecting a printer with a modified Centronics type I/F (col. 17, lines 19-20)" (answer, page 5). Based upon the teachings of Yokomizo, the examiner concluded (answer, page 5) that "[a]t the time the invention was made, one of ordinary skill in the art would have incorporated Yokomizo to Shimizu in order to improve the efficiency of utilization of the memory and to realize optimum memory configurations (col. 1, line 1 - col. 5, line 5)." In response to the appellant's challenge (brief, pages 11 and 12) to the proposed combination of reference teachings, the examiner noted (answer, page 13) that "a change in print image complexity, i.e. double sided images, will cause a more expensive printer to be used, and hence the cost for printing will be modified."

Appellant argues (reply brief, pages 3 and 4) that:

The Examiner continues to rely on an Ethernet controller for teaching aspects of the charge modification device. The Examiner contends that a print image complexity (e.g., double-sided) will cause a more expensive printer to be used, and therefore the cost will be modified. This conclusion on the modification of costs and complexity and variation in charge is complete speculation on the Examiner's part because Yokomizo is silent on this matter. The reference to any costs can relate purely to selection

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of an appropriate network printer based on throughput requirements. It need not have any cost relation to the amount of ad data as claimed. A prior art rejection cannot stand on the Examiner's unsupported assumption.

We agree with appellant's argument. Nothing in the record before us supports any of the examiner's assertions concerning the relevance of the teachings of Yokomizo to the claimed charge modification data device for modifying the charge for the amount of printed ad data. Stated differently, any changes in cost for the printer per se have no relevance to the claimed requirement for a charge modification data device for modifying the charge made for the amount of ad data printed with the other information. Accordingly, the obviousness rejection of claims 1 through 18 is reversed for lack of a prima facie case of obviousness.

DECISION

The decision of the examiner rejecting claims 1 through 18 under 35 U.S.C. § 103(a) is reversed.

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REVERSED



KENNETH W. HAIRSTON
Administrative Patent Judge



JOSEPH F. RUGGIERO
Administrative Patent Judge

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HOWARD B. BLANKENSHIP
Administrative Patent Judge

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